

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Marshall, Ian Peter

Serial No.: 10/797,643

Group Art Unit: 3736

Filed: March 10, 2004

Examiner: Lacyk, John P.

For: STIMULATION AID

Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pursuant to the Official Gazette Notice of July 12, 2005, Applicant respectfully requests Review of the Rejections that have been applied in the above-captioned patent application under the New Pre-Appeal Brief Conference Pilot Program.

I. The Claimed Invention

The present invention relates to an aid for female sexual stimulation. In the preferred embodiment that is shown in Figure 1 the invention includes a generally u-shaped implement having a first handle portion (1) and a second penetrative shaft portion (2) that are connected together at their respective proximal ends. The shaft portion (1) is curved re-entrantly at its distal end (5) to form a smooth nosed hook that extends generally towards a distal end (7) of the handle portion (1). The handle portion (1) has an inner face (4) that is adapted to act as an outer stimulator zone and an outer face (3) that is grippable to manipulate the implement.

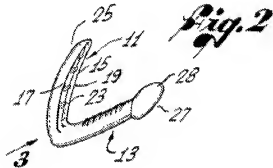
The aid is operable manually by holding the handle and using a rocking motion.

2. Rejection under 35 U.S.C. § 103(a) based on Sekulich, Jacobs and Januzzi

Claims 1-6 and 16-17 were rejected under 35 U.S.C. §103(a) based on a hypothetical combination of U.S. Patent No. 3,996,930 to Sekulich (hereinafter "Sekulich"), U.S. Patent 5,853,362 to Jacobs ("Jacobs" and U.S. Patent Publication 2004/0186344 to Januzzi ("Januzzi").



Sekulich discloses a V-shaped article that has an anterior leg 11 and a posterior leg 13. The device is 3 inches long and 5/16 of an inch in diameter. See col. 2, lines 1-4. The device is used by being inserted into a vagina (see Figure 1 of Sekulich at left) and is held in place by a woman's underwear, with the anterior leg 11 being angled and shaped to fit



against the undergarment. See col. 2, lines 40-41. The user controls the amount of stimulation desired through movements of her legs. The device further has a bulbous head 28 that is located at the end of posterior leg 12.

Sekulich is not a handheld device with a handle as is Applicant's claimed invention. It does not disclose or suggest in any way a handle having an inner face that is adapted to act as an outer stimulator zone and an outer face that is grippable to manipulate the implement, as Applicant's claim 1 recites.

Jacobs discloses an intravaginal glandular stimulator device that is worn internally by a woman. It is not intended to be held in place by a woman's underwear as is Sekulich. Unlike

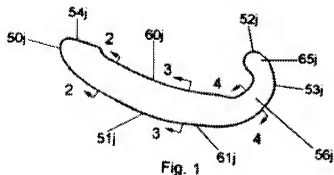


Fig. 1

Sekulich, it has a protruding penis-like shaft that may be used for having sexual relations with others. Jacobs has no handle portion. The Jacobs device also is plainly larger and thicker than the Sekulich article. According to MPEP 2143, to establish a *prima facie* case of obviousness, three basic criteria must be

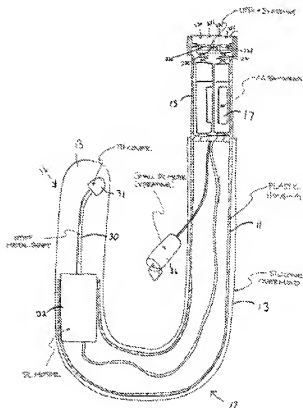
met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

There is no suggestion or motivation provided in Sekulich or elsewhere that would have led a person having ordinary skill in the art to modify the Sekulich to include a protruding penis-like shaft as Jacobs discloses. In fact, Sekulich teaches away from any such modification, because the modification would render the Sekulich device unable to function by being held in place by undergarments as is the stated use of the device. Sekulich is designed not to be a handheld device, so there is no motivation to give it a handle. It is accordingly difficult to see how a person having ordinary skill in the art might have found suggestion or incentive to combine the features of Jacobs with those of Sekulich as the rejection proposes.

Applicant's independent claim 1 recites a shaft portion that is curved re-entrantly at its distal end to form a smooth-nosed hook extending generally toward a distal end of a handle portion, and further specifies that the handle portion has an outer face that is grippable to

manipulate the implement. Jacobs has no handle portion. Sekulich has no handle portion, since it is intended to be secured to a woman's underwear rather than gripped. In order to supply a "handle portion" the Office Action turns to Januzzi, which discloses an article that is nothing like the stimulation aid that Applicant is claiming.

The Januzzi device (pictured at right) is a motorized vibrating device with batteries that has a generally cylindrical handle that is contoured all the way around, while Applicant is claiming a handle portion that has an interface that is adapted to act as an outer stimulator zone. There is no structure on Januzzi that is suitable for performing as an outer stimulator zone. There is no disclosure in Sekulich, Jacobs, Januzzi or any of the other references of record of a stimulation aid that has a handle wherein one face of the handle is grippable to manipulate the implement while another face of the handle is adapted to act as an outer stimulator zone, as Applicants independent claim 1 recites. If no reference discloses this, than any combination of the references will fail to have this feature as well. For that reason alone, all of the rejections applied in the Office Action are improper and should be withdrawn.



Given the differences between Sekulich, which is designed to be mounted to a woman's underwear, Jacobs, which is intended to be worn internally and Januzzi, which is intended to be externally manipulated it is difficult to see how a person having ordinary skill in the art would have genuinely contemplated combining the teachings of any two of these references, let alone cobbling together disparate elements of all three references as was proposed in the Office Action.

It is clear that this rejection was put together with the benefit of impermissible hindsight and is legally improper. It should properly be withdrawn.

The rejection of claim 7-14 adds yet a fourth reference, making it even less likely that a person having ordinary skill in the art would have found the requisite suggestion or incentive to combine the teachings of the references as proposed in the rejection.

3. Conclusion

Forcing Applicant to pay Attorneys Fees in order to contest these meritless rejections would be unjust. Applicant respectfully requests a thorough review of the rejections during the pre-appeal conference, a withdrawal of the rejections discussed above and the speedy passage of this Application to Issue.

Respectfully submitted,

/JLK/

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